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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,989	09/26/2001	Roland N. Walker	12160.2	2969
21999	7590	11/15/2007	EXAMINER	
KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111			BALDWIN, GORDON	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			11/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/964,989	WALKER, ROLAND N.	
	Examiner	Art Unit	
	Gordon R. Baldwin	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 August 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 12-15,26,27,35 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 12-15,26,27,35 and 37-41 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

Claims 12-15, 26-27, 35 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skonecki (Pat. No. 5,305,550) and further in view of Roulleau (Pat. No. 5,142,976).

Consider claims 12, 13, 35, 37-41, Skonecki teaches an organic product such as a fresh natural flower, such as a rose, in a natural configuration in which the product is provided with a personalized message or drawing inscribed on one of its petals. (Col. 1 lines 24-38). Skonecki does not require a pad-printed image, however, Roulleau teaches an organic product in which the surface of the product comprises pad printed images. (Col. 1 lines 61-65) It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the organic product of Skonecki with a pad printed image so as not to damage, or etch or cut the surface of the organic product when the image is printed on the surface on the organic product and in order to provide the surface of the organic product with a repeatable and identical image.

Regarding claims 15 and 27, patentability of product-by process claims are based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

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Regarding claims 14 and 26, Skonecki teaches the inscription may be a personalized message such as the word, "congratulations". (See Skonecki Fig. 1)

Response to Arguments

Applicant's arguments filed 8/31/2007 have been fully considered but they are not persuasive.

The arguments stated below (except for the arguments involving commercial success, long-felt need and licensing) are repeated from the last rejection because they are still considered to be valid.

First, the teaching of Roulleau is considered to teach a reasonable expectation of success by the fact that an unbroken or compromised fragile organic structure can have a pad-printing process applied to it without causing damage to the structure. While the Skonecki reference is used to show that flowers, flower petals, can have an ink-based message applied to them, without destroying the flowers structure. Therefore, the combination of the two references is considered to show that a fragile uncompromised organic product in a roughly oval shape (like the flower blossom in Skonecki and the egg of Roulleau) is capable of having a pad printed image applied to it by an automated mechanism.

Second, as for the "delicate" nature of a flower versus an uncompromised egg, while an egg may have a more rigid structure than a flower, the flower has an elasticity that would allow for a substantial compressive force to be applied and still recover to its original shape or in a shape very close to the original shape. While an egg is not

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capable of reproducing such a action since once its compressive threshold is exceeded, the egg for all intensive purposes is unusable as a decorative object. Without the actual pad-printing pressures claimed by the applicant, in addition to those of the prior art references, it is difficult to determine the actual differences between the applicant's pad-printing process versus Roulleau, however without a distinct showing from the claims or the specification, it is not clear exactly how the printing process of the surface of an egg would not work on the surface of an oval shaped blossom as shown by the applicant in the drawings.

Third, concerning the statement of Roulleau about breaking an already cracked egg. A cracked egg only has a thin membrane, which is generally cut through initially by the shards of shell and breached, and breaking once any amount of force is applied. This argument is not considered persuasive because a flower blossom has a reasonably substantial amount of resilience, while neither a cracked nor an uncracked egg is going to have such a resilience.

Lastly, while the argument concerning the rotation of the flower as compared with the egg is understood, in reference to the Roulleau reference and its, "screw jack" system, but this argument is not considered pertinent since the flowers may be placed on the conveyor system in such a way as to eliminate the likelihood of having a split mark on different petals.

While the experimentation requested by the applicant has been considered, the subjective nature of the experiment, (such as to what degree is the egg cracked?) is not exactly clear and it not considered to carry a great deal of weight with regard to the

amount of pressure a flower versus the amount of pressure a cracked egg can absorb and still be a viable product.

Licensing, Commercial Success and Long-felt Need Discussion

Concerning the applicant's arguments regarding the commercial success of the article. The MPEP states in chapter 716.03, "An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating: In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constitute commercial success. C.f. Ex parte Remark, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990) (evidentiary routine of shifting burdens in civil proceedings inappropriate in ex parte prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide **hard evidence** of commercial success. In re Huang , 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996)

The MPEP also states in Chapter 716.03, "In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the

consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973)

Conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight. *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973). With that said, the statements in the affidavits in no way give credence to a declaration of commercial success since no market share or hard sales figures were given by the applicant or the license holder. Therefore the statements of the licensees are entitled little weight since they are conclusory. General statements regarding increased sales simply do not cover the variables that might lead to the increased sales of a certain item.

The indication of increased sales of the item utilizing the claimed invention is not considered to validate the claim of commercial success unless it shows evidence that the gain in market share is attributable to the claimed invention, because the MPEP chapter 716.03 (b) (IV) states, "Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

As for the assertion of Commercial Success, the affidavits provided by the applicant simply do not provide enough hard data points to properly maintain a commercial success argument to overcome an obviousness rejection. Generally, the applicant provides conclusive assertions regarding the reasons why people purchased or licensed the invention with very little empirical evidence. This scenario is considered to fall under *In re Huang*, which states that the Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between sales and the claimed invention. *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996).

Additionally, statements by the applicant insinuating increased sales due to the claimed invention and attempting to create a nexus between the claimed invention and commercial success by a mere showing that there was commercial success of an article, which embodied the invention, is not considered sufficient to show commercial success. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990).

There needs to be a greater showing of many other factors such as prices of the competitors in the same area of floral arrangements, customer testimonials or a showing of long felt need in the market.

Evidence of licensing is a secondary consideration must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits. *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985) Therefore, the

applicant's evidence of a variety of testimonials about their licensing agreements only stand to show that a contractual agreement formed, but the agreements do not necessarily show a nexus between the claimed invention and commercial success. These agreements may have been formed to negate infringement suits.

As for the long-felt need argument, the applicant, according to MPEP 716.04, must show, I) the need must have been a persistent one that was recognized by those of ordinary skill in the art, II) the long-felt need must not have been satisfied by another before the invention by the applicant and III) the invention must satisfy the long-felt need. The applicant's only argument in favor of the long-felt need, besides the showing of licensing agreements, is an excerpt from the Skonecki reference that states, "All the pens in the group are operable to enable the paint to flow from a tip thereof onto the petal by applying minimal pressure to the petal with the tip, thereby preventing damage to the petal." (Skonecki, Col. 2 lines 14-19) While it is not clear which of the criteria the applicant is attempting to satisfy, this statement is considered (by the examiner) to state that the long felt need was a way to mark on a flower petal without damaging it. The Skonecki reference satisfies this need by teaching a method of applying a personalized message or drawing to a (flower) petal (Claim 1), which satisfies criteria number (II) and (III). The applicant has not shown the long-felt need has not been satisfied by another (especially Skonecki) before the claimed invention of the applicant (number II). Additionally, criteria (I) was never addressed by the applicant and therefore not considered to be fulfilled.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon R. Baldwin whose telephone number is (571)272-5166. The examiner can normally be reached on M-F 7:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GRB



JENNIFER MCNEIL
SUPERVISORY PATENT EXAMINER
4/9/17